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Inventor/title: Mansfield/Product Recall Communication
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ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.41 REPLY BRIEF

Sir:

In response to the examiner's answer dated October 16, 2009, the appellant responds as follows:

1. In the examiner's answer dated October 16, 2009, with respect to the rejections of claims 3, 12, and 55 under 35 USC 103(a) as being unpatentable over Knegendorf in view of Abreu, and official notice, the examiner states:

> However Official Notice is taken that it is notoriously well known that consumers who purchase recalled products were typically compensated with vouchers (discount incentives) good for future purchase of a similar (yet safe) product or rebates refunding consumers for money spent on replacement (safe) versions of the product. One such example can be found in "Gilje, Shelby, "Jugs, Pans Pose a Lead hazard," Seattle Times, Third Edition, June 25, 1986, pg C7." In it, it is taught that merchandise vouchers for defective items (a pan and a jug) were provided to customers who purchased either defective item. It would have been obvious to one of ordinary skill at the time of the invention to have provided such a voucher good for a new version of the defective product, so that customers of Knegendorf et al/Abreu could be assisted in the purchase of a replacement (safe) item. It would have been further obvious to one of ordinary skill at the time of the invention to have offered any of such typical restitution option within the

automated recall system of Knegendorf et al in view of Abreu so that consumers can be fairly made whole for the recalled product - either by known rebate techniques or discount voucher techniques. [Examiner's answer page 4 line 23 through page 5 line 15.]

In response, and further to the response presented in the appeal brief filed February 27, 2009 spanning pages 6-10, the appellant notes the following:

In support of the examiner's allegation that it is "well known that consumers who purchase recalled products were typically compensated with vouchers (discount incentives) good for future purchase of a similar (yet safe) product or rebates refunding consumers for money spent on replacement (safe) versions of the product.", the examiner cites three new references in the examiner's answer: "Jugs, Pans Pose a Lead hazard", "Quotes: Dear Doctor: I own a 1992", and "SMART MONEY Product Recalls Rebate for coffee makers, extended muffler coverage".

The appellant objects to the examiner's post-appeal reliance upon new evidence for a prior rejection. The panel should refuse consideration of the examiner's reliance on new evidence on appeal, since that constitutes a new ground of rejection.

> Appellants urge that the ultimate criterion of whether a rejection is considered "new" in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection. We agree with this general proposition, for otherwise appellants could be deprived of the administrative due process rights established by 37 CFR 1.196(b) of the Patent and Trademark Office. [In re Kronig, 539 F.2d 1300, 1303, 1976 CCPA LEXIS 140; 190 USPQ 425, ___ (CCPA 1976).]

> The criterion of whether a rejection is considered "new" in a decision by the Board is whether appellants have had fair opportunity to react to the thrust of the rejection. In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). [Ex parte Werner K. Maas and Carlton L. Gyles, 1987 Pat. App. LEXIS 18; 9 USPQ2d 1746; 14 USPQ2d 1762 (BPAI 1987).]

> Because our rationale for sustaining the rejections of claim 30, and claims 31 through 35 which stand or fall therewith, differs from that advanced by the

examiner, we hereby designate our action in this regard as a new ground of rejection under 37 CFR § 1.196(b) in order to afford the appellant a fair opportunity to react thereto. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). [Ex parte Bollinger, Appeal No. 2004-0106 Application 09/907,974, 2001 Pat. App. LEXIS 112, 8 (BPAI November 22, 2001).]

37 CFR 41.39 precludes a new ground of rejection in an examiner's answer, unless the answer expressly designates the rejection as a new ground of rejection, since such designation affords the appellant specific procedural relief, as specified in 37 CFR 41.39(b(1) and (2). This examiner's answer contain no such designation. As such, it is procedurally improper. The panel should refuse consideration of the Answer, or at least the new ground contained therein, on this basis.

Assuming arguendo the examiner's new references are considered, the rejections would still be improper because neither "provid[ing] such a voucher good for new version of the defective product" nor "offer[ing] any such typical restitution option", which are the facts underlying the examiner's taking of official notice, would suggest what is claimed.

Claims 3 and 55 define a system that integrates POS functions or transaction item logging with consumer identification, recall notification, - - and follow-on marketing associated with those consumers whose prior purchase is subject to the recall. The combination of the five cited references and the examiner's officially noticed facts do not disclose a terminal of a retail store computer system responding and providing the associated rebate or incentive offer. In contrast, claim 3 recites (and claim 55 defines) that "providing ... via said a terminal or kiosk of a retail store computer system" the associated rebate or incentive offer. Accordingly, even assuming arguendo entry of the three new references and the examiner's official notice as fact, the rejections are improper and should be reversed.

Because none of the references cited by the examiner disclose "providing ... via said a terminal or kiosk of a retail store computer system" the associated rebate or incentive offer, the rejections of claims 3 and 55, and all of the claims that depend therefrom, are improper and should be reversed.

Respectfully Submitted,

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Date: 12/8/2009

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BTM

December 8, 2009 (11:16am)

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